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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,346	03/12/2004	Kozo Nogi	Q80405	5598

65565 7590 01/03/2007

SUGHRUE-265550
2100 PENNSYLVANIA AVE. NW
WASHINGTON, DC 20037-3213

EXAMINER	
ZEMEL, IRINA SOPJIA	
ART UNIT	**PAPER NUMBER**
1711	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/03/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/798,346	NOGI ET AL.	
	Examiner	Art Unit	
	Irina S. Zemel	1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 October 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-17* is/are pending in the application.

4a) Of the above claim(s) *16 and 17* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6 and 12-14* is/are rejected.

7)☒ Claim(s) *7-11, 15* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Claims 16-17 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 10-2-2006.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1, 6, 12-14 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 5,672,633 to Brehm et al., (hereinafter "Brehm").

As per discussion in the previous office action, Brehm discloses a process for surface crosslinking treatment of a water-absorbing resin powder by adding a surface crosslinking agent to a water-absorbing resin powder and heat treating the mixture, wherein the water-absorbing resin powder after the heat treatment is stirred and cooled under an air flow. See illustrative example 1 in columns 7-8 disclosing surface treatment and air cooling in fluidized bed. Insofar as the newly added limitation to stirring the water adsorbing resin powder mechanically or by vibration and cooling under a forced air flow, this steps necessarily and inherently take place upon cooling the

powder in a fluidized bed, which, by its very design vibrates the powder by forced air flow.

Insofar as the limitations of claim 6, the limitations are directed to a machine, which is not even recited in the base claim 1. There is absolutely no requirement that the recited machine is even used in the claimed process. It has been held that to be entitled to weight in method claims, the recited structure limitations therein must affect the method in a manipulative sense, and not to amount to the mere claiming of a use of a particular structure. Ex parte Pfeiffer, 1962 C.D. 408 (1961).

Claim 12 recites the passage that stirring and cooling step "comprises stirring the water-absorbing resin powder under a forced air flow while continuously or batchwise cooling the powder in a mixing machine having a forced cooling function." The examiner is of the position that in the absence of clear definition of what "forced cooling function: is, this limitation is met by the cooling the powder in a fluidized bed as the cooling is conducted by force flowing fluid through the powder.

Similarly, claims 13-14 recites physical characteristics and capabilities of an apparatus without requiring this capabilities to be used in the process. A fluidized bed apparatus has a rotational axis (normally it is cylindrical), and is capable of the recited functions by design. Whether the functions are utilized in the process disclosed by the reference, is as discussed above, immaterial.

The invention as claimed, thus, is fully anticipated by the disclosure of the Brehm reference.

Claim Rejections - 35 USC § 102/103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 2 and 5 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over US Patent 5,672,633 to Brehm et al., (hereinafter "Brehm").

The rejection stands as per reasons of record and the discussion above insofar as the new limitations of the base claim 1, which are similar to the amendment of claim 2. The amendments of claim 5 (besides making it dependent on claim 1) are directed to clarification issues only.

Claim Rejections - 35 USC § 103

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brehm.

The rejection stands as per reasons of record and the discussion above insofar as the new limitations of the base claim 1. The amendments of claim 3 are directed to clarification issues only.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brehm in combination with US patent 4,295,281 to Potter (hereinafter "Potter").

The rejection stands as per reasons of record and the discussion above insofar as the new limitations of the base claim 1. Claim 4 does not contain any amendment.

Response to Arguments

Applicant's arguments filed 10-2-2006 have been fully considered but they are not persuasive. The applicants argue that the claims as amended recite treatment of powder by stirring and cooling under an air flow. The applicants further state that "as described at page 27, 1st full paragraph of the present specification, the term "under an air flow" as used in the present application refers to forced ventilation of the cooling machine." By this argument the applicants imply that the amended claim require interpretation of the claim clause "under an air flow" as forced ventilation of the cooling machine. The examiner can not agree with this argument. It is well established in the art that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The passage referred by the applicants on page 27 merely states that "The term "under an air flow" as referred to herein means that an air flow (flow of a gas) is essential in the space of the cooling machine." Nowhere in the referred passage (or anywhere else in the specification) is defined as meaning strictly "forced ventilation of the cooling machine". Moreover, the claimed limitation to the "stirring the water adsorbing resin powder mechanically or by vibration and cooling under a forced air flow" does not add anything specific that is not inherently met by the process of operating a fluidized bed which inherently utilized forced air flow and by using it inherently vibrates (shakes) the powder.

Insofar as the argument regarding the disclosure of Potter, the applicants state that Potter does not disclose operation of fluidized bed under reduced pressure (generating air flow under reduced pressure), rather it teaches that operation at or near

atmospheric pressure is preferred. While the reference may disclose some preferred embodiments at atmospheric pressure, it has been long established by the case law that a reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill the art, including nonpreferred embodiments. *Merck & Co. v. Biocraft Laboratories*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), *cert. denied,* 493 U.S. 975 (1989). Thus, in view of expressed disclosure of the Potter reference to the vacuum operation of the fluidized bed, such operation is anticipated by the Potter reference.

Allowable Subject Matter

Claims 7-11 and 15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art does not suggest either adding aqueous solution during the cooling step (which is considered unpbvious on fluidized bed apparatus cooling of powders), or a cooling step in a machine as per claim 15.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Irina S. Zemel whose telephone number is (571)272-0577. The examiner can normally be reached on Monday-Friday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571)272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Irina S. Zemel
Primary Examiner
Art Unit 1711